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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNI79.013AUS	6418
20995 7590 01/09/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER AHMAD, NASSER	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 01/09/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcarter@kmob.com
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Office Action Summary

Application No.

10/618,957

Applicant(s)

YAMAMOTO ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 10-117 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 10-12, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Election/Restrictions

2. Newly submitted claims 16-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 16-17 are directed to a method for protecting a transparent conductive surface, classified in class 349, subclass 187;

Original claims 8, 10-12, 14 and new claim 15 are directed to a transparent surface protective film, classified in class 428, subclass 40.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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process of using that product. See MPEP § 806.05(h). In the instant case the product of Group II can be used for attaching it to a window pane, which is different from a conductive surface.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Rejections Maintained

3. Claims 8, 10-12, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Masuda (US 20020064650A1) made in the Office Action of 10/15/2007 has been withdrawn in view of the amendment filed on 10/31/2007.

4. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda made in the Office Action of 10/15/2007 has been withdrawn in view of the amendment filed on 10/31/2007.

Response to Arguments

5. Applicant's arguments filed 10/31/2007 have been fully considered but they are not persuasive.

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First, applicant is directed to the amendment, page-4, the paragraph referring to claim 8, recites that "Claims 10-12 depend from claim 14" which is assumed to be incorrect because said claims 10-12 actually depend from independent claim 8.

Regarding applicant's argument about Masuda, in that, it discloses controlled 3-70% transmission of light through it's layers and does not teach that all the layers of the film are transparent, and hence, Masuda's film is not transparent. This is not deemed to be convincing because the instant claim do not specify the amount of transparency, and in the absence of said amount, the phrase "transparent", in the claims 8 and 14, is a relative term because the relative transparency can vary, in the absence of any definition provided by the originally filed specification.

For claims 10-12, the above explanation apply *a fortiori* herein.

Applicant's arguments for new claims 16-17 are moot in view of the withdrawal of said claims, based on election by original presentation, as explained hereinabove.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position tha the claimed invention is anticipated by the prior art of record discussed hereinabove.

The following is a ground of rejection for the new claim 15:

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Masuda (US 20020064650A1).

Masuda relates to a transparent surface protective film (paragraph-[0001] recites that the film is for protecting windows and is transparent because the visible light transmittance is 3-70% as mentioned in paragraph-[0019]) **consisting of** a transparent polyester film (paragraph-[0019]), a transparent adhesive (paragraph-[0044]) coating on one side of the film (the adhesive is deemed to be transparent because the film protects transparent windows), and an antistatic layer is formed on at least the other side of the film (abstract and paragraphs-[0031] and [0032]). The polyester film includes three layers with an intermediate layer containing a dye (abstract) and this reads on the claimed "polyester film" because said film is not limited to a single layer or excludes the presence of dye, which still teaches the transparency of said film. The antistatic layer comprises polymers having pyrrolidinium rings as repeating units in the main chain thereof (paragraph-0034] teaches that the pyrrolidinium rings are in the backbone of the polymer and hence, will have repeating units).

The reference mentions that the laminate exhibits excellent antistatic properties. It is also understood by the examiner that the polyester film is well known to be transparent, acrylate adhesive is known in the art as being transparent and the antistatic layer is also transparent, as is admitted in the instant application.

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Further, the laminate would inherently exhibit the maintaining of transparency even after one-hour heat treatment at 150 degrees C.

The intended use phrases such as "for transparent conductive substrates", etc. have not been given any patentable weight because said phrases are not found to be of positive limitations.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nasser Ahmad
Primary Examiner 1/3/07
Art Unit 1794

N. Ahmad.
January 3, 2008.